

### **REMARKS**

This responds to the Office Action dated February 9, 2005, and the references cited therewith.

No claims are amended or cancelled. Claims 45-62, 100, and 101 remain pending in this application.

#### **Information Disclosure Statement**

Applicant submitted a Supplemental Information Disclosure Statement and a 1449 Form on November 15, 2004. Applicant respectfully requests that initialed copies of the 1449 Forms be returned to Applicant's Representatives to indicate that the cited references have been considered by the Examiner.

#### **§103 Rejection of the Claims**

Claims 45-53, 55-57, 59-60 and 62 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Yamamoto (U.S. Patent No. 3,803,457) in view of Farahmandi et al. (U.S. Patent No. 6,451,073).

#### **Claims 45-52**

Applicant traverses the obviousness rejection of claim 45 since there is no suggestion to make the asserted combination. The Yamamoto reference discusses a capacitor including a plurality of rolled cylindrical capacitors. (Abstract). The Yamamoto reference itself includes no reference to first and second flat stacks of capacitors, as claimed. The Office Action states that Farahmandi sets forth flat capacitor stacked plates. The Examiner asserts "it would have been obvious to modify the Yamamoto system with the same, such a choice dependent on the end use of the device."

Applicant notes that a suggestion to combine must come from the prior art and not from Applicant's specification or impermissible hindsight. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior

art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991); MPEP § 2143. The Examiner must avoid hindsight. *In re Bond*, 910 F.2d 831, 834, 15 USPQ2d 1566, 1568 (Fed. Cir. 1990). In this case, there is no suggestion in either reference as to the necessary steps to convert the Yamamoto cylindrical capacitor into a flat stack capacitor, as asserted by the Office Action.

Moreover, the Office Action did not provide a specific reason to support an obviousness rejection. The Examiner must provide a specific reason to support an obvious rejection. *Ex parte Humphreys*, 24 USPQ2d 1255 (B.P.A.I. 1992). Since the Office Action only stated "it would have been obvious to modify the Yamamoto system with the same, such choice dependent on the end use of the device," and did not provide a specific reason why it would have been obvious to combine the references, the Office Action has not made a prima facie case for obviousness.

Claims 46-52 include each limitation of their parent claim and are therefore also not anticipated by the cited reference. Reconsideration and allowance is respectfully requested.

#### Claims 53 and 55-57

Claim 53 recites providing a first flat stack of capacitive elements where each element comprises flat anode plate and a flat cathode plate with an electrolyte interposed therebetween, and providing a second flat stack of capacitive elements. Applicant believes this subject matter is not obvious in view of the cited references and the discussion for claim 45 is incorporated herein by reference.

Claims 55-57 include each limitation of their parent claim and are therefore also not anticipated by the cited reference. Reconsideration and allowance is respectfully requested.

#### Claims 59, 60, and 62

Claim 59 recites a first flat stack of one or more flat capacitive elements in the first compartment, and a second flat stack of one or more flat capacitive elements in the second compartment. Applicant believes this subject matter is not obvious in view of the cited references and the discussion for claim 45 is incorporated herein by reference.

Claims 60 and 62 and 100-101 include each limitation of their parent claim and are therefore also not anticipated by the cited reference. Reconsideration and allowance is respectfully requested.

§103 Rejection of the Claims

Claim 54 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Yamamoto (U.S. Patent No. 3,803,457) in view of Farahmandi et al. (U.S. Patent No. 6,451,073) and further in view of Inagawa et al. (U.S. Patent No. 6,324,049).

Claim 54 includes each limitation of its parent claim 53. Applicant believes claim 54 is not obvious in view of the cited references since the secondary reference does not overcome the deficiencies of the primary reference discussed above. Reconsideration and allowance is respectfully requested.

Claims 58 and 61 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Yamamoto (U.S. Patent No. 3,803,457) in view of Farahmandi et al. (U.S. Patent No. 6,451,073) and further in view of Yoshida (U.S. Patent No. 4,394,713).

Claims 58 and 61 include all the limitations of their respective parent claims. Applicant believes the claims are not obvious in view of the cited references since the secondary reference does not overcome the deficiencies of the primary reference discussed above. Reconsideration and allowance is respectfully requested.

CONCLUSION

Applicant respectfully submits that the claims are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney at (612) 359-3267 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

MICHAEL J. O'PHELAN ET AL.

By their Representatives,

SCHWEGMAN, LUNDBERG, WOESSNER & KLUTH, P.A.  
P.O. Box 2938  
Minneapolis, MN 55402  
(612) 359-3267

Date 8/9/05

By Peter C. Maki  
Peter C. Maki  
Reg. No. 42,832

CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 9 day of August, 2006.

Paula Sully  
Name

Paula Sully  
Signature